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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,717	12/30/2004	Qin Xu	P70334US0	7510
136 7590 12/22/2008 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER				
MISKA, VIT W				
ART UNIT		PAPER NUMBER		
2833				
MAIL DATE		DELIVERY MODE		
12/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,717

Applicant(s)

XU ET AL.

Examiner

Vit W. Miska

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 15-23 and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi (6047163) in view of the new patent cited to Itoh et al (5696518).

3. With respect to claims 15 and 30, Miyoshi disclose a timepiece (Fig. 6) comprising a middle 61, a watch movement 65 housed in the middle, a transceiver circuit (col. 3, line 35, col. 5, line 21) associated with said movement and an antenna 61 connected to said emitter receiver circuit, wherein said antenna 61 is formed by a solid electrically conductive mass (col. 3, line 46) having the shape of at least a portion of a ring (Figs. 6 and 7), this mass being disposed on the periphery of said middle so as to be externally visible, said antenna being connected to the transceiver circuit by way of a conductor 62.

4. With respect the limitation "said mass being disposed on an outer periphery of said middle", Miyoshi suggests a modification where the antenna portion 61 is provided on the left and right sides of a box type watch case (col. 4, lines 1-2). Such modification would result in the claimed "mass being disposed on the outer periphery of said middle. The disposition of an antenna on an outer portion of a watch case is further taught by Itoh et al, which disclose an antenna 100 disposed on an outer periphery of a middle 201 of a timepiece. It would be obvious for one of ordinary skill in the art to place portion 61 of the antenna of Miyoshi et al at the outer sides of a watch middle as suggested in the modification of Miyoshi at col. 4 and as shown by Itoh et al in order to provide a detachable antenna component. It would further be obvious to place conductors from the antenna to the transceiver circuitry inside the timepiece through the wall of the middle, as shown at 62 of Miyoshi and at 115 of Itoh et al as an obvious manner of connecting the timepiece circuitry with the antenna.

5. Regarding claim 16, Miyoshi further discloses said conductive solid mass forms a decorative portion contributing to an appearance of said timepiece (inherently, the exterior antenna provides a decorative portion.

6. With respect to claim 17, it would be obvious for one skilled in the art to engage antenna portion 61 of Miyoshi in a groove of a lateral surface of a middle, as shown in Itoh et al, with antenna 100 disposed in a groove of the middle 201 as seen in Fig 2, as an obvious manner of attaching the antenna to the watch case.

7. Regarding the remaining claims in order, Miyoshi further discloses wherein said timepiece includes a glass disk 69 and said conductive solid mass forms at least a portion of a bezel -surrounding said glass disk (antenna 61 forms a portion of a bezel of the watch as seen in Figs. 6 and 7),

wherein said conductive solid mass constitutes a closed ring (Fig. 7),

wherein said middle is made of electrically conductive material (col. 5, line 10 suggesting metallic screws and thus, a metallic middle 201 in Itoh), said conductive solid mass being separated therefrom by an insulator 151 in Itoh et al (when Miyoshi is modified as suggested above to dispose conductive antenna 61 at the sides of a case middle),

wherein said insulator is made of a material chosen from the group consisting of the nitrile rubbers, hydrogenated nitrile rubbers, polyurethanes, silicones, polymers and ceramics (plastic is suggest at col. 5, line 4 of Itoh),

wherein said conductive solid mass and said insulator are fixedly attached to said middle by at least one of the following operations: chasing, screwing, bonding, brazing, crimping and/or riveting (screws 152 in Itoh),

wherein said conductive solid mass is made of material from the group consisting of stainless steel and zirconia charged with conductive particles (steel would be an obvious available and conventional metal for metallic antenna portion 61),

further comprising a conductive element 66 forming a ground plane for said antenna,

wherein said middle is metallic, said element forming the ground plane including a back of said middle,

wherein said antenna is a capacitive antenna type and is connected directly to said transceiver circuit (see abstract).

8. With respect to claim 27, rear cover 66 in Miyoshi is made of metallic material; however, for wristwatches with non-metallic material (e.g. plastic) cases and back covers, it would be obvious for one skilled in the art, to achieve the same results of providing a capacitive antenna in a timepiece, to use a metallic piece against the inside of back cover for defining a return path in the antenna circuit.

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi and Itoh et al, as applied to claim 23 above, in further view of Bach. Miyoshi or Itoh et al do not suggest coating the antenna mass with rhodium or diamond. However, it is known to provide a coating of diamond on an exterior surface of a watch, as shown in Bach at 38. It would be obvious for one skilled in the art to provide such a coating for the exterior surface of solid mass 61 of Miyoshi in order to add a decorative effect to the timepiece, as taught by Bach.

Response to Arguments

10. Applicant's comments have been given careful consideration, but are moot in view of the new ground of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Renee Luebke can be reached on 571-272-2009. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vit W. Miska/
Primary Examiner, Art Unit 2833